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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,546	06/05/2003	Ernst Kraenzler	1969	7609
7590	02/06/2006		EXAMINER	
Michael J Striker Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743				CHUKWURAH, NATHANIEL C
		ART UNIT		PAPER NUMBER
		3721		

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

MK

Office Action Summary	Application No.	Applicant(s)	
	10/049,546	KRAENZLER ET AL.	
	Examiner	Art Unit	
	Nathaniel C. Chukwurah	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 November 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 16-29,31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 31 and 32 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 16,17 and 19-28 is/are rejected.
- 7) Claim(s) 18 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 February 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

The rejection of the Office Action made with the reference of Wolfe et al., which was mailed 7/26/2005 has been withdrawn because the Priority document was not filed with the application at the time of the Office Action and the filing date of the reference was applied in the rejection.

Election/Restrictions

Newly submitted claims 31-32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 16-28, drawn to power tool comprising at least one grip, a mounting part and elastic- vibration damping element, classified in class 173, subclass 162.1.
- II. Claims 31-32, drawn to method for producing a power tool comprising the steps of firmly connecting at least one grip part to a mounting part by at least one elastic-vibration damping element, fixing the grip part to a housing via mounting part, classified in class 29, subclass 81.17.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

In the instant case the product of Group II can be made by a process other than the process of Group I. For example, the tool could be made without dissipating heat from the internal region of the elastic element or the retaining element and the elastic-vibration damping element may be formed before connecting the grip part.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-32 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16- 17, 19-20, 22-23, 26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Forderer et al. (US 5,699,865).

With regard to claim 16, Forderer et al. et al. discloses a power tool with at least one handle (19) which comprises at least one grip part (19) firmly connected to and held at a mounting part (35 , 45) by at least one elastic, vibration-damping element (22), and the grip part affixable to a housing (2), via the mounting part (35 , 45), and the connection between the grip

In the instant case the product of Group II can be made by a process other than the process of Group I. For example, the tool could be made without dissipating heat from the internal region elastic element or the retaining element and the elastic-vibration damping element may be formed before connecting the grip part.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-32 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16- 17, 19-20, 22-23, 26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Forderer et al. (US 5,699,865).

With regard to claim 16, Forderer et al. et al. discloses a power tool with at least one handle (19) which comprises at least one grip part (19) firmly connected to and held at a mounting part (35, 45) by at least one elastic, vibration-damping element (22), and the grip part affixable to a housing (2), via the mounting part (35, 45), and the connection between the grip

part (19) and the mounting part (35, 45) by means of the elastic element is secured by at least one movable retaining element (50). See (col. 5, line 29).

With regard to claim 17, Forderer et al. does not expressly state that the retaining element is flexible. The retaining element (50) is inherently flexible to a degree.

With regard to claim 19, the retaining element (50) is located in the elastic element (22) along a center line (see Fig. 2).

With regard to claim 20, retaining element (50) is capable of being subjected to tensile stresses and the elastic element (22) is capable of being subjected to compressive stresses.

With regard to claims 22 and 23, the retaining element (50) is formed by a rigid component that is rigidly supported and capable of moving relative to the mounting part (45) and grip part (19).

With regard to claim 26, the power tool of Forderer et al. includes the retaining element (45) being connected the to grip part (19) via the elastic element (22) and to the mounting part (35) via the elastic element (22).

With regard to claim 28, the power tool of Forderer et al. includes elastic element comprising non-circular cross- section area at least closely before the seating surface (36) of the elastic element (22) for the mounting part (35) and grip part (19) wherein the cross- sectional area is smaller than the seating surface (Fig. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forderer et al. in view of Raddle et al. (US 5,697,456).

With regard to claim 21, the power tool of Forderer et al. discloses all claimed subject matter but lacks specific teaching of the retaining element formed by a band which encloses the elastic element.

The power of Radle et al. teaches a retaining element (100) formed by a band which encloses the elastic element (96, 98) for protective covering.

In view of the teaching of Radle et al., it would have been obvious to one skilled in the art at the time of the invention to provide the power tool Forderer et al. with the retaining element formed by a band enclosing the elastic element for protective covering.

With regard to claim 27, the displacement of the elastic element (22) is determined by the retaining element (50) in tilting direction.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forderer et al. in view of Dorner et al. (US 5,46,566).

With regard to claims 24 and 25, the power tool of Forderer et al. discloses all claimed subject matter but lacks specific teaching of the retaining element firmly connected to a fastening screw located in mounting part.

However, the power tool of Dorner et al. teaches a retaining element (50, 60) firmly connected to a fastening screw (55) located in mounting part (41) for holding the elastic element fixedly to the motor.

In view of the teaching of Dormer et al., it would have been obvious to one skilled in the art at the time of the invention to provide the power tool Forderer et al. with a fastening screw in order to hold the elastic element fixedly to the motor and to prevent transferring vibrations from the motor to the handle unit.

Allowable Subject Matter

Claim 18 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:
The prior art of record fails to disclose a retaining element formed by a rope.

Response to Arguments

Applicant's arguments with respect to claim 16-28 and 31-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

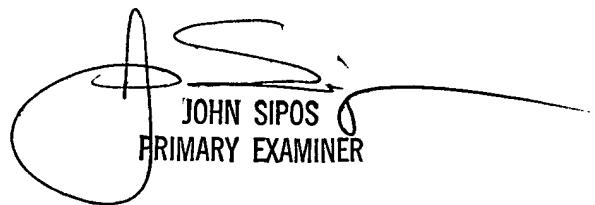
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is (571) 272-4457. The examiner can normally be reached on M-F 6:00AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NC

January 30, 2006.



JOHN SIPOS
PRIMARY EXAMINER